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| Stephen C. Kaufman | | | PHAM, MICHAEL | |
| Intellectual Property Law Dept. | | | | |
| IBM Corporation | | | ART UNIT | PAPER NUMBER |
| P.O. Box 218 | | | 2167 | |
| Yorktown Heights, NY 10598 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|---|------------------------|---------------------|
| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) |
| | 10/743,158 | AMITAY, EINAT |
| | Examiner | Art Unit |
| | MICHAEL PHAM | 2167 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) They raise the issue of new matter (see NOTE below);
- (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 37-45 and 56-63.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. Other: _____.

/John R. Cottingham/
Supervisory Patent Examiner, Art Unit 2167

/M. P./
Examiner, Art Unit 2167

Claim status: Claims 37-45 and 56-63 are unamended.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's assert the following with regard to the cited prior art:

A. Page 4 paragraph 5, That Prokoph is not relevant to the claimed invention. That this is because he does not deal with web indexes. That in fact, he is very specific that he is not dealing with them, citing paragraph 6 of prokoph. Stating that because "a typical search pattern will result in an unwieldy number of search hits, making it difficult to analyze the results" makes clear that he is not dealing with web indexes.

In response, this is disagreed. Prokoph paragraph 6 is merely disclosing problems of current search indexing. This does not demonstrate that he teaches away, but rather recognizes a need for improvement. Prokoph does this by creating a document extract. In doing so alleviates the amount of storage. In figure 2 the crux of Prokoph's description discloses a web index as a search index in 207. The search index is improved because the amount of information to be stored is significantly reduced, see 0034.

B. Page 4-5, That Prokoph does not disclose "adding information from at least some of said user queries to said enhanced web index" and "searching an enhanced web index".

In response, applicant's are directed to the rejection. "adding information from at least some of said user queries to said web index" was disclosed by Cole. "Searching an enhanced web index" was disclosed by Prokoph.

C. Page 4-5, that Prokoph does not disclose web indexes so he obviously does not teach searching them or updating them.

In response, this is disagreed. Prokoph discloses a web index as a search index. The search index is for web documents as seen in figures 1 and 2. Updating and searching the search index, is done by running the system of figure 2.

D. Page 5 paragraph 1, Prokoph explains why searching web indexes is inadequate in his opinion. That he again is clarifying that while he knows about them he is not dealing with web indexes, concluding by citing portion of paragraph 9.

In response, this is disagreed . Prokoph discusses problems with current search indexes. Then discusses a system to improve the search indexes as seen in figure 2 by utilizing a document extract. Therefore, Prokoph recognizes web search indexes, and further improves upon them. One may even call it an enhanced web index.

E. Page 5 paragraphs 3-5, That the teaching of Kim could not or would not be used with prokoph. That this is because Kim is contrary to Prokoph because Prokoph says the file would be too big and unusable. That thus there is no real motivation.

In response, the examiner disagrees. While Prokoph discloses that a problem of search indexes are that an enormous amount of data on the internet that is stored. In doing so, Prokoph discloses providing a document extract that cuts the amount of data in order refine the index. Prokoph did not disclose using anchor text in the search index. However Kim disclosed using anchor text for an index in order to provide for faster retrieval. Both are within the same field of endeavor, namely searching. Both disclose indexes. Prokoph while reduces the size of the index, the objective of Prokoph is not to take out data completely but rather to extract relevant data. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided anchor text to the search index to provide for more relevant results, Kim 0029.

F. Page 5-6, That when an inventor says he is not using a certain element because of certain stated problems, it most certainly is not obvious to introduce that very element into his system. Prokoph created a system which operates without web indexes, and is intended not to use them.

In response, this is disagreed. Prokoph clearly uses a web index as seen in figure 2 element 207.

G. Page 6 paragraphs 1-4, That Examiner's is using hindsight reasoning. That Kim is contrary to Prokoph because Prokoph does not disclose the use of web indexes. Applicant's assert why would someone incorporate a web index of Prokoph if he says not to use them? Why incorporate a web index into prokoph if it requires a change in his principle invention?

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Prokoph discloses the problem of an enormous amount of data on the internet to be stored in web search indexes. That the solution in

Prokoph discloses providing a document extract that cuts the amount of data in order to refine the index. Prokoph did not disclose using anchor text in the search index. However, Kim disclosed using anchor text for an index in order to provide for faster retrieval 0029. Both are within the same field of endeavor as applicant's invention. Both disclose search indexes. Prokoph while reduces the size of the index, the objective of Prokoph is not to merely take out data completely in order to reduce the size, but rather to extract relevant data to be searched. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided anchor text to the search index to provide for more relevant results, Kim 0029.

Kim's index is not contrary to Prokoph's index because Prokoph uses a web index, as seen in figure 2 element 207.

Prokoph does use a web index as noted above in figure 2 element 207, thus this does not change Prokoph's principle invention but rather improves on it by further allowing the use of anchor text in order for faster retrieval and to provide more relevant results.

H. Page 6-7, "searching an enhanced web index" and "adding information from at least some of said user queries to said enhanced web index" is not disclosed.

In response, please see B.

I. Page 7, paragraph 1, Prokoph does not deal with web indexes and even suggests that they should not be used.

In response, this is disagreed, please see figure 2 element 207. In regards to Kim please see parts E and G.

J. Page 7 paragraph 2, that Cole does not deal with adding information to such a web index.

In response, this is disagreed. It is a web index, because the keywords are associated with objects or documents. See figure 2 element 250, and col. 1 lines 16-17, "indices or similar data structures that associate keywords or terms with the documents or other objects". Therefore, Cole discloses a web index. And further provided in the rejected claim discloses adding keywords from user queries to the index.

K. Page 7 paragraph 3-4, Cole is working with a "keyword index" as opposed to a "web index". These two different types of indices with very different purposes. That instead of adding the query words to repository 115, Cole is adding the query words to his keyword list in his search engine. That accordingly, it is clear that Cole does not teach "adding information from at least some of said user queries to said enhanced web index".

In response, the examiner disagrees that the reference does not disclose "adding information from at least some of said user queries to said enhanced web index". As stated in part J, Cole further discloses a web index, since the index is an association between the keywords and the objects (documents). Applicant's are again directed to Col. 4 lines 63-col. 5 lines 1-2 which states "if the user enters a response which indicates satisfaction, the first query stored is parsed into keywords. Each keyword is associated with an object, and optionally, statistics of date usage are updated for each association. Under Alternative A, the Master Index is updated with these associations."

Accordingly, Cole discloses the claimed adding information (keywords) from at least some of said user queries (queries) to said enhanced web index (index).

The index is updated with the associations between keyword and object. The index is further a web index in that it is an index of documents. See col. 4 lines 63-col. 5 line 2.

The index in Cole and the index in the claimed limitation is not of different purpose. They are both indexes. They are both indexes of documents. They are both indexes used for search of documents, they are further indexes that are updated by user queries.

L. page 7-8, Applicant's state that Cole is not teaching a web index. That Cole recognizes they are not updating a web index, citing column 2 lines 5-10.

First, it was stated that Prokoph disclosed a web index.

Second, this is further disagreed. The search system itself in Cole discloses that this can be done via internet, see col. 3 line 5. Thus the documents are "web documents", and the index itself is a "web index".

M. Page 8, paragraph 2, That in summary, Prokoph does not disclose a web index and that Prokoph states specifically not to use them.

In response, this is disagreed. Furthermore, the statement has no merit because there is no support. Applicant merely states that Prokoph does not use a web index. Prokoph discloses a web index as seen in figure 2 element 207.

N. Page 8 paragraph 2, That there is no basis to incorporate Kim with Prokoph.

Please see part E.

O. Page 8 paragraph 2, That Cole makes no mention of web indexes and only updates keyword indexes.

Please see above responses in regards to cole. It was stated that Prokoph disclosed a web index. Prokoph did not disclose updating an index with user queries. The Cole reference disclosed a an index that is updated with associations of keywords and objects (i.e. documents). It therefore would have been obvious to Prokoph to update the web index with keywords in order to provide more user relevant search results.

P. Page 8 paragraph 3, that there is no reason to add kim because Prokoph knew about web indexes and said not to use them. That kim adds nothing to what Prokoph didn't know.

In response, it is disagreed that Prokoph does not use web indexes. See figure 2 element 207, there it discloses a search index, which is equivalent to a web index. Prokoph merely did not disclose that the search index contained anchor text in the index. Kim disclosed an indexed that included anchor text as seen in the cited portions of Kim.

In conclusion, the assertions provided by applicant, are not persuasive enough to over come the cited prior art. It is advised to further amend the claim in order to further distinguish the claimed limitations from the cited prior art.